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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/789,597

02/27/2004

Kirt Martin

STE01 P-1158

9061

277 7590 01/19/2007
PRICE HENEVELD COOPER DEWITT & LITTON, LLP
695 KENMOOR, S.E.
P O BOX 2567
GRAND RAPIDS, MI 49501

EXAMINER

HAWK, NOAH CHANDLER

ART UNIT

PAPER NUMBER

3636

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/789,597	Applicant(s) MARTIN ET AL.	
	Examiner Noah C. Hawk	Art Unit 3636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) 20-63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayles in US Patent 4287837 in view of Long in US Patent 3000681 and Diamond et al. in US Patent 3698329.

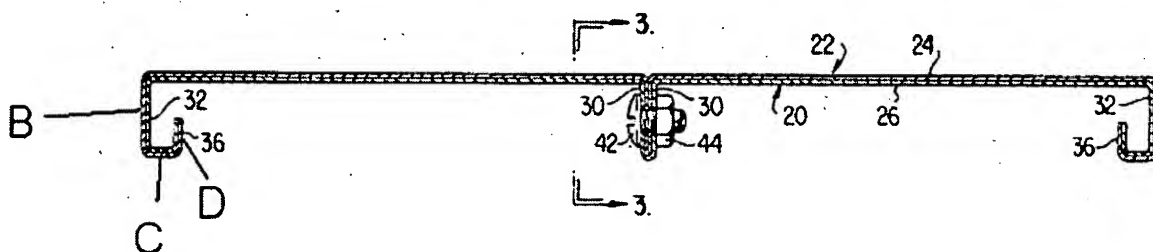
- a. Regarding Claim 1, Bayles teaches a privacy screen (18) for use within a desk assembly having a worksurface (12) and an open span (A, best seen in Bayles, Figure 2) located below the worksurface comprising a first member (18) having a generally planar first portion (best seen in Bayles, Figure 2), a first flange (58) extending longitudinally along the first planar portion, and a first end (52) and a second end (54) adapted to be secured to a desk assembly within an open span (A) located below a worksurface (12) of the desk assembly. Bayles fails to teach a telescoping privacy screen. Long teaches a device including a telescoping privacy screen (22 and 22a) for use in different sized desks. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Bayles by using a telescoping privacy screen as taught by Long in order to "fit different desk dimensions" (see Long, Column 1, lines 9-10).

Bayles, as modified, does not teach details of the telescopically adjusting second portion of the privacy screen. Diamond et al. teach a panel having two members (20, 22), the first member (20) having a generally planar first portion (best seen in Diamond et al., Figure 1), a first flange (32) extending longitudinally along the first planar portion and a second member (22) having a generally planar second portion (best seen in Diamond et al., Figure 1), a second flange (36) extending longitudinally along the second planar portion and configured to telescopically receive the first flange of the first member therein such that planar second portion is substantially proximate the planar first portion thereby allowing adjustment of an overall length of the panel extending between the first end and the second end. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Bayles, as modified, by using a telescopically adjusting panel as taught by Diamond et al. in order to allow the user to mount the panel on a diverse selection of desks with different span sizes.

- b. Regarding Claim 2, Bayles, as modified, further teaches that the first flange (58) is substantially C-shaped (best seen in Bayles, Figure 2).
- c. Regarding Claim 3, Bayles, as modified, fails to teach details of the second flange. Diamond et al. further teach that the second flange (36) includes

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a first portion (B) extending from and substantially orthogonal to the second planar portion, a second portion (C) extending from and substantially orthogonal to the first portion, and a lip portion (D) extending from the second portion and towards the second planar portion. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Bayles by using a flange with three portions as taught by Diamond et al. in order to allow the panel to be folded into shape.

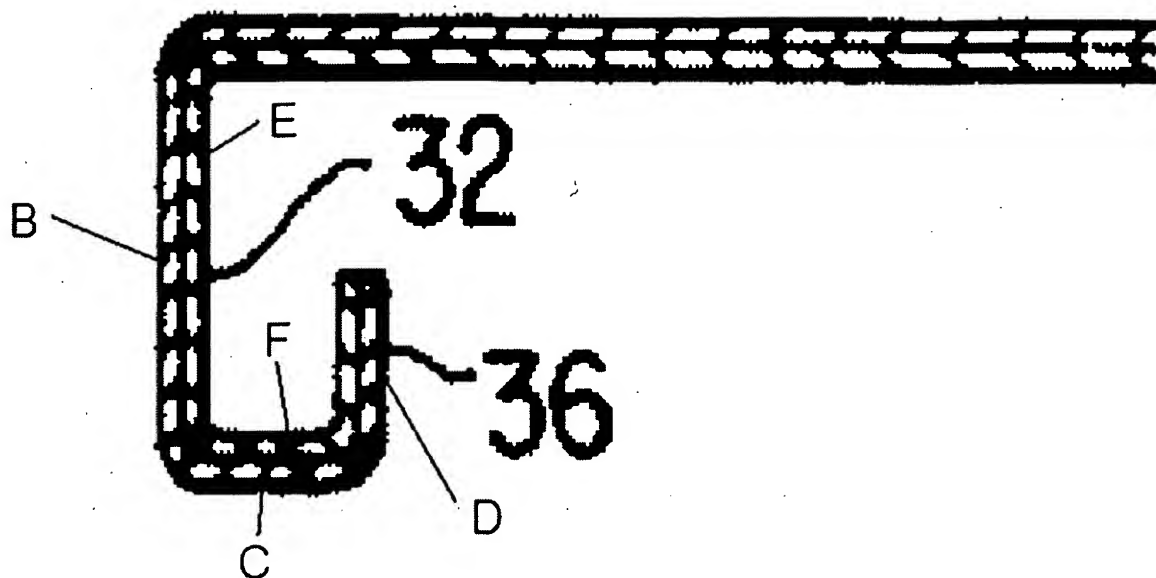


Diamond, et al., Figure 2

d. Regarding Claim 4, Diamond et al. further teach that the second flange (36) is substantially C- shaped (best seen in Diamond et al., Figure 2). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Bayles, as modified, by using a C-shaped second flange as

taught by Diamond et al. in order to more securely receive the flange portion of the first member.

e. Regarding Claim 5, Diamond et al. further teach that the first flange (32) includes a first portion (E, best seen in Diamond et al., Figure 2 Detail, below) extending from and substantially orthogonal to the planar portion and a second portion (F) extending from and substantially orthogonal to the first portion of the first flange, and wherein the second portion (F) of the first flange is telescopingly received between the second portion (C) of the second flange and the lip portion (D) of the second flange (Note: the second portion of the first flange is considered received by the second flange as it resides in the space defined by the second portion and the lip portion). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Bayles, as modified, by using a two-portion first flange as taught by Diamond et al. in order to allow the panel to be folded into shape. (Emphasis added)



Diamond et al., Figure 2 (Detail)

f. Regarding Claim 6, Diamond et al. further teach a first upper flange (30) extending longitudinally along the first planar portion and a second upper flange (34) extending longitudinally along the second planar portion, wherein the first upper flange and the second upper flange are substantially proximate to one another when the first member and the second member are telescopingly assembled (best seen in Diamond et al., Figure 2). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Bayles, as modified, by using upper flanges as taught by Diamond et al. in order to provide a more secure fit between the two panels on the top edge.

g. Regarding Claim 7, Diamond et al., further teach that at least a select one of the first upper flange and the second upper flange includes at least one aperture (38, 40) extending therethrough that is adapted to receive a fastener. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Bayles, as modified, by using apertures in the upper flanges as taught by Diamond et al. in order to provide and alternate mounting means on the top edge. Please note that the phrase "for securing the privacy screen to the worksurface" is considered functional language and is given very little patentable weight.

h. Regarding Claim 8, Bayles, as modified, further teaches that at least a selected one of the first end and the second end includes an end flange (52) that includes at least one aperture (64) extending therethrough that is adapted to receive a fastener for securing the privacy screen to the desk assembly.

i. Regarding Claim 9, Diamond et al. further teach a first upper flange (30) extending longitudinally along the first planar portion and a second upper flange (34) extending longitudinally along the second planar portion, wherein the first upper flange and the second upper flange are substantially proximate to one another when the first member and the second member are telescopingly assembled (best seen in Diamond et al., Figure 2). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Bayles, as modified, by using upper flanges as taught by Diamond et al. in order to provide a more secure fit between the two panels on the top edge.

j. Regarding Claim 10, Diamond et al., further teach a first upper flange (30) extending longitudinally along the first planar portion and a second upper flange (34) extending longitudinally along the second planar portion and that at least a select one of the first upper flange and the second upper flange includes at least one aperture (38, 40) extending therethrough that is adapted to receive a fastener. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Bayles, as modified, by using apertures in the upper flanges as taught by Diamond et al. in order to provide and alternate mounting means on the top edge. Please note that the phrase "for securing the privacy screen to the worksurface" is considered functional language and is given very little patentable weight.

k. Regarding Claim 11, Bayles, as modified, further teaches that at least a selected one of the first end and the second end includes an end flange (52) that includes at least one aperture (64) extending therethrough that is adapted to receive a fastener for securing the privacy screen to the desk assembly.

3. Claims 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayles in US Patent 4287837 in view of Long in US Patent 3000681 and Diamond et al. in US Patent 3698329.

l. Regarding Claim 12, Bayles teaches a desk assembly, comprising a worksurface (12), a first supporting member (14) supporting the worksurface, a second supporting member (16) supporting the worksurface, wherein the first supporting member and the second supporting member cooperate to define a

span (A) therebetween, and a privacy screen assembly, comprising a first member (18) having a generally planar first portion (best seen in Bayles, Figure 2), a first flange (58) extending longitudinally along the planar first portion, a first end (52) adapted to be secured to the first supporting member and a second end (54) secured to the second supporting member (best seen in Bayles, Figure 1).

Bayles fails to teach a telescoping privacy screen. Long teaches a device including a telescoping privacy screen (22 and 22a) for use in different sized desks. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Bayles by using a telescoping privacy screen as taught by Long in order to "fit different desk dimensions" (see Long, Column 1, lines 9-10). Bayles, as modified, does not teach details of the telescopically adjusting second portion of the privacy screen. Diamond et al. teach a panel having two members (20, 22), the first member (20) having a generally planar first portion (best seen in Diamond et al., Figure 1), a first flange (32) extending longitudinally along the first planar portion and a second member (22) having a generally planar second portion (best seen in Diamond et al., Figure 1), a second flange (36) extending longitudinally along the second planar portion and configured to telescopically receive the first flange (best seen in Diamond et al., Figure 2) such that planar second portion is substantially proximate the planar first portion such that the first member and second member are telescopically adjusted with respect to one another to extend across an entire length of a span. It would have been obvious to one of ordinary skill in the art at the time of

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invention to modify the device of Bayles, as modified, by using a telescopically adjusting panel as taught by Diamond et al. in order to allow the user to mount the panel on a diverse selection of desks with different span sizes.

m. Regarding Claim 13, Diamond et al. further teach that the first flange (32) of the first member (20) is substantially C-shaped (best seen in Diamond et al., Figure 2). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Bayles, as modified, by using a C-shaped first flange as taught by Diamond et al. in order to more securely connect the two panel members.

n. Regarding Claim 14, Diamond et al. further teach that the second flange (36) of the second member (22) includes a first portion (B) extending from and substantially orthogonal to the first planar portion, a second portion (C) extending from and substantially orthogonal to the first portion, and a lip portion (D) extending from the second portion and towards the first planar portion. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Bayles, as modified, by using a flange with three portions as taught by Diamond et al. in order to allow the panel to be folded into shape.

o. Regarding Claim 15, Diamond et al. further teach that the second flange (36) is substantially C-shaped (best seen in Diamond et al., Figure 2). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Bayles, as modified, by using a C-shaped second flange as

taught by Diamond et al. in order to more securely fit into the receiving portion of the first flange.

p. Regarding Claim 16, Diamond et al. further teach that the first flange (32) of the first member (20) includes a first portion (E, best seen in Diamond et al., Figure 2 Detail, above) extending from and substantially orthogonal to the planar portion of the first member and a second portion (F) extending from and substantially orthogonal to the first portion of the first flange, and wherein the second portion (F) of the first flange is telescopingly received between the second portion (C) of the second flange and the lip portion (D) of the second flange (Note: the second portion of the first flange is considered received by the second flange as it resides in the space defined by the second portion and the lip portion). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Bayles, as modified, by using a two-portion first flange as taught by Diamond et al. in order to allow the panel to be folded into shape. (Emphasis added)

q. Regarding Claim 17, Diamond et al. further teach a first upper flange (30) extending longitudinally along the first planar portion of the first member and a second upper flange (34) extending longitudinally along the second planar portion of the second member, wherein the first upper flange and the second upper flange are substantially proximate to one another when the first member and the second member are telescopingly assembled (best seen in Diamond et al., Figure 2). It would have been obvious to one of ordinary skill in the art at the

time of invention to modify the device of Bayles, as modified, by using upper flanges as taught by Diamond et al. in order to provide a more secure fit between the two panels on the top edge.

r. Regarding Claim 18, Diamond et al., further teach a first upper flange (30) extending longitudinally along the first planar portion of the first member and a second upper flange (34) extending longitudinally along the second planar portion of the second member and that at least a select one of the first upper flange and the second upper flange includes at least one aperture (38, 40) extending therethrough that receives a fastener. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Bayles, as modified, by using apertures in the upper flanges as taught by Diamond et al. in order to provide and alternate mounting means on the top edge. Please note that the phrase "thereby securing the privacy screen to the worksurface" is considered functional language and is given very little patentable weight.

s. Regarding Claim 19, Bayles, as modified, further teaches that at least a selected one of the first end and the second end includes an end flange (52) that includes at least one aperture (64) extending therethrough that receives a fastener (68) therethrough, thereby securing the privacy screen to at least a selected one of the first support member and the second support member the desk assembly.

Response to Arguments

4. Applicant's arguments filed 10/10/06 have been fully considered but they are not persuasive.

5. In response to applicant's argument that "selecting only certain portions of the waste basket as disclosed by Long requires an impermissible picking-and-choosing of certain elements thereof..." , the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The combination of reference does not "combine a trash can with a privacy screen", rather the combination with Long is used to show the teaching of a screen that is telescopingly expandable to fit across a span of space under a desk. It is maintained that it would have been obvious to combine a privacy screen (as taught by Bayles) with the expanding aspect of Long's device to adjust the screen to different size desks and to allow for sizing differences introduced in a desk during manufacture.

6. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Regarding the combination with Diamond, the Diamond reference is merely used

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to teach expanding metal plate elements that could be used for any telescopically expanding metal sheet device.

7. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

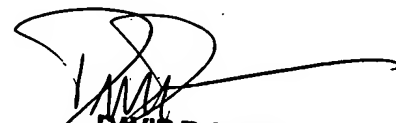
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Noah C. Hawk whose telephone number is 571-272-1480. The examiner can normally be reached on M-F 9am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Dunn can be reached on 571-272-6670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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DAVID R. DUNN
PRIMARY EXAMINER